

**REMARKS**

This Response is submitted on February 21, 2008. Claims 1-19, 21-23, and 25-37 were rejected under 35 USC § 112 first and second paragraph. Claims 1-19, 21-23 and 25-37 were also rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,385,586 by Dietz in view of U.S. Patent No. 6,901,360 by Dymetman et al. Claims 1-19, 21-23, and 25-37 are pending after entry of the present Response. Reconsideration is respectfully requested.

**Rejections under 35 U.S.C. §112**

Claims 1-19, 21-23 and 25-37 were rejected under the first and second paragraph of 35 U.S.C §112. Applicant respectfully submits that the disclosure provides support for how the system would work without performing language translation. For example, Figure 3 and Figure 4 along with the associated text in the as-filed application beginning on page 11, line 9, through page 14, line 2 provide an overview of how some embodiments of the system would work. Additionally, page 13, lines 6-12 of the as-filed application provides additional support for altering an expression without performing language translation.

Applicant also respectfully submits that the negative limitation has support within the as-filed application on page 11, lines 5-7, where it is stated that, "For example, the conversion process 204 may include a translator that translates speech in one language to another language." Please note that in the preceding portion on page 11, lines 2-4, the application recites that, "...the conversion process can be used to control various characteristics such as, tone, accents, intonation, and effects such as echo, reverberation, and so on.". Thus, subsequent discussion of Figure 3 and Figure 4 should be applied to the

conversion process to control both characteristics such as tone, accents, intonation or the alternative element of language translation.

In light of the preceding, Applicant respectfully submits that the negative limitation is in compliance with MPEP 2173.05(i) that states, "If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims." See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). Additionally, while Applicant believes that the original disclosure provides the necessary basis for the negative limitation, MPEP 2173.05(i) also states, "Note that lack of literal basis in the specification for a negative limitation may not be sufficient to establish *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

Applicant respectfully submits that in light of the preceding arguments, the 35 U.S.C §112 rejections have been traversed.

#### **Rejections under 35 U.S.C. §103(a)**

Claims 1-19, 21-23, and 25-37 were rejected under 35 U.S.C §103(a) as being unpatentable over U.S. Patent No. 6,385,586 to Dietz in view of U.S. Patent No. 6,901,360 to Dymetman et al. (hereinafter "Dymetman"). Applicant respectfully submit that the combination of Dietz and Dymetman is improper because it contravenes MPEP 2141.02 VI that states, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)

Applicant respectfully submits that after traversing the 35 U.S.C. §112 rejection the inclusion of the negative limitation is proper. Thus, where Applicant explicitly excludes

language translation Dietz, when considered as a whole as proscribed by MPEP 2141.02 VI, repeatedly and extensively is concerned with language translation. In the Response to Arguments of the Office Action, the Office notes that, "Performing language translation is design choice or obvious to select/not select based on system/user demand." As the title of Dietz includes the phrase, "...to enable language translation devices" Applicant respectfully disagrees that language translation is a design choice of Dietz. Furthermore, Figure 2 and Figure 3, along with the corresponding description repeatedly and explicitly refer to "language translation".

Also included in the Response to Arguments of the Office Action is the output characteristics of Dietz that includes "geographic location". When viewed as a whole, as instructed by MPEP 2141.02 VI, the geographic location of Dietz is used to determine language translation parameters based on the location of a user (column 4, lines 31-65), (column 7, lines 11-19). Thus, Applicant respectfully submits that when Dietz is considered in its entirety, it would lead away from Applicant's claimed subject matter after removal of the 35 U.S.C. §112 rejection.

Applicant also respectfully submits that the proposed combination of Dietz and Dymetman contravenes MPEP 2143.01 V that states, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As illustrated in Figure 2 and described in the specification of Dietz, the I/O device 201 captures the voice to be translated, communicates with the server providing the translation and receives the translated language data from the server (column 5, lines 40-55). Thus, Dietz, even in light of Dymetman, is principally concerned with outputting language

translation from the *first computer, I/O device 210*. Therefore, the Examiners proposed combination of Dietz and Dymetman to produce audible sound output from the *second computer*, would render Dietz unsatisfactory for its intended purpose. Where the Office wishes to produce audible sound from Dietz's *second computer*, Dietz explicitly states that audible sound data is to be sent to the *I/O device, or first computer*.

In light of the previous arguments, Applicants respectfully submits that the proposed combination of Dietz and Dymetman is in contravention of MPEP 2143.01 V and therefore there is no suggestion or motivation to make the proposed modification.

Similarly, Applicant respectfully submit that the proposed combination of Dietz and Dymetman contravene MPEP 2143.01 VI that states, "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie obvious*."

As recited in Dietz, "Outputting in audio form requires a text-to-voice application 211 which converts the desired language text into an audio output *for sending to I/O device 210*." (Column 6, Lines 4-7). Dietz, even in light of Dymetman, is principally concerned with outputting language translation from the *first computer, I/O device 210*. Therefore, the Examiners proposed combination of Dietz and Dymetman to produce audible sound output from the *second computer*, would change the principle of operation of Dietz. Where the Office wishes to produce audible sound from Dietz's *second computer*, Dietz explicitly states that audible sound data is to be sent to the *I/O device, or first computer*.

Applicant believes that the proposed combination of Dietz and Dymetman is improper because it would change the principle of operation of the Dietz in violation of

MPEP 2143.01 VI. Therefore, Applicant respectfully submits that the combination of Dietz and Dymetman is insufficient to render the claimed invention *prima facie* obvious.

Applicant would also like to respectfully note the difference between the claimed "an expression to be applied to the content data", and "expression" as used in Dymetman. Dymetman states, "The first expression 111 comprises a plurality of words in the first language." (Column 9, Lines 32-33). Dymetman further explains that, "From the second plurality of representation 171, 172 and 173 one or more appropriate representations may be selected to obtain the second expression 181 in the second language." (Column 10, Lines 9-12). Thus, Dymetman is using "expression" to define sentences and Dymetman's "expression" at best, may be considered analogous to Applicant's "content data". As such, for Dymetman to teach *applying an expression* to the content data would be nonsensical because it could be interpreted as teaching applying content data to the content data.

Although Applicant has amended the claims to cover a specific embodiment with a negative limitation excluding language translation and made arguments specific to the claimed invention, the limitations and arguments are specific to this application and should not be considered limiting to any continuation application. Applicant reserves the right to file a continuation application with claims directed to other aspects disclosed in the specification of the present application, at a later time, if so desired.

In view of the foregoing arguments in the present Response, Applicant believes the application is now in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present Response, the Examiner is kindly requested to contact the undersigned at (408) 774-6911. If any other fees are due in connection with filing this Amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805. (Order No. SONYP009). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,  
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